

### **REMARKS/ARGUMENTS**

In view of the amendments and remarks herein, favorable reconsideration and allowance of this application are respectfully requested. By this Amendment, claim 71 has been amended solely for clarity, and claims 45-46, 55-56, and 63-64 have been cancelled without prejudice of disclaimer. Thus, claims 43-44, 47-54, 57-62, and 65-79 are pending for further examination.

#### **Objection to the Specification**

The specification has been objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. This objection is respectfully traversed for at least the following reasons.

It appears that the Office Action employs an overly formalistic, hyper-technical, and improperly rigid view of what is required by 37 C.F.R. § 1.75(d)(1) and MPEP 608.01(o). MPEP 608.01(o) begins by stating that “[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import. . . .” Notably, literal or “*in haec verba*” support is not required by 37 C.F.R. § 1.75(d)(1) or MPEP 608.01(o). Quite the contrary, the sole requirement is that the meanings of claim terms be apparent from the specification and/or figures. Here, one of ordinary skill in the art would be able to understand the meaning of each and every one of the terms found objectionable in the Office Action -- particularly when those terms are read in the context of the surrounding claim language.

By way of example and without limitation, it is noted that:

- Paragraph 23 states that “Each of the jukebox devices includes a subset of the master library on a local storage device of the jukebox.” This provides ample support for “a first storage location.”

- Paragraph 25 indicates that “Each jukebox device has a local server 22 that can be accessed by the jukebox device. . . . The local servers 22 each preferably include a mirror copy of the master library of musical recordings maintained by the central server 12.”), and paragraph 9 states that “The local server may even be installed within the housing of the jukebox device itself if space permits.” This provides ample support for “a second storage location.”
- Figs. 3-6 clearly visually depict portions of “a user interface,” and the corresponding descriptions in specification explain in detail how each portion of the user interface function.
- Paragraph 9 states that “In other words, the user can first search the local storage on the jukebox for desired songs and then, if desired, search further on the local server for desired songs. If the desired song is found on the local storage it is played from the local storage for a normal fee. On the other hand, if the song is only found on the local server, the song can be immediately downloaded, at the option of the user, from the local server to the jukebox for playing for a fee that is preferably higher than the normal fee.” This provides ample support for “collection of an appropriate fee or number of credits.”
- Paragraph 5 discusses a jukebox including a hard drive, and paragraph 34 discusses a local server including a hard drive. These paragraphs provide ample support for the term “disk drive.”
- An “encryption level” is described in paragraph 26 and also was present in the originally filed claims.
- A “predetermined number of bytes” is described in paragraph 26.

- A “repository of instances of media” is described at least in paragraph 23’s indication that “The central server 12 includes a master library of songs (and/or other content).”

In view of the above, reconsideration and withdrawal of outstanding objections are respectfully requested.

**Rejections under 35 U.S.C. § 112, First Paragraph**

Claims 43-60, 63-64, and 69-79 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. It is believed that the explanations above and/or the cancellation of certain claims render moot each and every basis for this rejection, with the possible exception of the final basis regarding first and second subsets. However, Applicant’s disclosure is not limited to particular exemplary embodiments described in the Background section of the specification. Applicant therefore respectfully submits that the citation to and exclusive reliance paragraph 5 is misplaced. As properly pointed out, paragraph 23 discloses a first subset of the master library on the local storage device of the jukebox. A second subset may be stored on a local server, with that local server being included in a particular jukebox device, as explained in paragraphs 9 and 25, for example. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

**Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 43-79 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. This rejection is respectfully traversed for at least the following reasons.

First, Applicant respectfully submits that the meaning of the term “storage location” is clear when the relevant limitations in the claims are read in their entireties. Applicant

appreciates the Office Action's citations to particular definitions and technical publications. However, there are a number of problems with the Office Action's approach and any indefiniteness only arises when these definitions are employed. For example, the definition of "location" advanced in the Office Action is circular, as the Office Action's definition first defines a "location" as an "address," and then defines an "address" as a "location." It is fundamental that a term cannot be used in its own definition. Furthermore, Applicant does not disagree with the general observation that conflicts can be caused when two components want to write to a specific location or address in memory. However, Applicant notes that the claim language reciting a "first storage location storing a first plurality of instances of media" would not present this type of conflict unless the same portion of the storage location were being used by multiple instances of media. In other words, no conflict would exist if three 3 MB media files were stored in a 9 MB storage location. It is perhaps the case that the Office Action has taken the further interpretation that a storage location is the smallest or simplest portion to which data can be saved. However, one skilled in the art would agree that each of a bit, a byte, a megabyte, etc., is to some extent a storage location, and the Office Action's interpretation is improper because it is unduly narrow. In sum, the term "storage location" is clear when the relevant limitations in the claims are read in their entirety and any lack of clarity or indefiniteness is introduced only when the Office Action's unnecessary "definitions" are introduced. Thus, reconsideration and withdrawal of this portion of the § 112, second paragraph rejection are respectfully requested.

Second, Applicant notes that competitors would be on notice as to whether they would infringe claims 75-77 when the express language of these claims is considered as a whole. Claim 75 specifies that "the second display screen is configured to display search results after at

least some instances of media not included in the first subset of media are searched for instances of media matching the search criteria.” Thus, claim 75 describes the structure of the second display screen in terms of function, e.g., by describing the time at which it is configured to display certain results. One skilled in the art would not find this to be a purely functional limitation. Moreover, one skilled in the art would be able to determine whether the second display screen displays the appropriate information at the appropriate time. Thus, there is nothing inherently wrong with claim 75.

Claim 76-77 describe which subset(s) of media is/are searched. How that subset or those subsets of media is/are to be searched is inconsequential and need not be described in order for the claims to be clear and definite, or for a would-be infringer to be able to assess the scope of the claim and to make an infringement determination. Applicant declines the Office Action’s apparent invitation to artificially and unnecessarily restrict the scope of the claims.

As such, reconsideration and withdrawal of this portion of the § 112, second paragraph rejection are respectfully requested

**Rejections under 35 U.S.C. § 103**

Claims 43-45, 47-49, 53-55, 57-63, and 65-67 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles (U.S. Patent No. 5,481,509) in view of Applicant’s Admitted Prior Art (AAPA). This rejection is respectfully traversed for at least the following reasons.

The Office Action admits that Knowles does not teach or suggest “a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits” as recited in claim 43 and cites to a single sentence in

paragraph 6 of Applicant's specification to make up for this admitted deficiency with respect to Knowles. However, this single sentence, together with the twelve-word alleged rationale for making the alleged modification, fails to render obvious claim 43.

More particular, the Office Action notes that paragraph 6 of Applicant's specification states that "jukebox systems have in the past provided a feature which enables the user to search for songs on the central server from the jukebox and request an immediate download of a desired song from the central server to the jukebox for an additional fee," and argues that it would have been obvious to one of ordinary skill in the art at the time of the invention because "this [allegedly] would give the user access to a larger selection of songs." However, this conclusory rationale, to the extent understood, is incorrect.

First, it is noted that claim 43 does not call for a local server. The Office Action does not assign a meaning to the term "local server," and it is not at all clear that a "local server" would inherently provide for the feature admittedly missing from Knowles. Applicant's own specification indicates that a local server of the kind described therein (which most certainly is not prior art) does not need to charge an enhanced fee for an instance of music. It would appear that the Office Action has a bit more explaining to do when attempting to demonstrate that a local server (a term found later in Applicant's specification) would necessarily lead to the feature admittedly missing from Knowles. Of course, the use of the term "local server" is strongly indicative of the resort to improper hindsight in making this rejection.

Second, the sentence from Applicant's specification pertains to a central server, not a local server. As explained in the context of certain exemplary embodiments of Applicant's invention -- not the prior art -- local servers have different structures and perform markedly different tasks as compared central servers. For instance, local servers help overcome challenges

presented in connection with jukebox systems that include only central servers -- including download speed issues, more local coordination of jukeboxes with smaller areas, etc.

Conversely, a central server is better equipped to manage all royalty and accounting information, maintain a master library of media, etc. As the specification explains, providing local servers in addition to central servers can lead to a number of example advantages. As such, it is clear that a central server cannot take the place of a local server, or vice versa, as the two are simply not interchangeable. There would be no need to replicate a central server at a local level, and to do so would even seem contrary to the purpose of providing a central server in the first place.

Third, the allegation that providing a local server would “give the user access to a larger selection of songs” is incorrect. As described in Applicant’s specification, providing a local server generally only gives a user quicker access to a subset of instances of media. A local server in exemplary embodiments of Applicant’s invention, by definition, cannot provide more songs over and above those included in the master list on the central server. In other words, “quicker” access is not the same as “more” access.

Similar arguments apply with respect to claim 53, which recites, *inter alia*, “a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits,” as well as claim 61, which recites, *inter alia*, “providing a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits.” In fact, the recitation of a central server directly in claim 53 drives a further wedge in the “reasoning” presented in the Office Action.

In view of the above, Applicant respectfully submits that the Office Action has not made out a prima facie case of obviousness with respect to claims 43, 53, and 61 (and their respective dependents).

Claims 71-79 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles in view of Shneidlman (U.S. Publication No. 2006/0038794). This rejection is respectfully traversed for at least the following reasons.

Despite the Office Action's admissions regarding the deficiencies of Knowles regarding claims 43, 53, and 61, the Office Action curiously does not make similar admissions in the context of claim 71. As previously explained at length and as now admitted in the context of certain other claims, however, Knowles simply does not teach price differentiation of any kind -- much less "a user interface provided to the jukebox device configured to receive input from a user corresponding to a selection of an instance of media from the instances of media in order to initiate playback of the selected instance of media on the jukebox device, the user interface comprising a first display screen configured to receive input from a user for the selection of the instance of media for playback from the first subset of media for a first fee or number of credits, and a second display screen configured to receive input from a user for the selection of the instance of media for playback from at least the second subset of media for a second fee or number of credits, the second fee or number of credits being greater than the first fee or number of credits," as called for in claim 71.

It appears that the Office Action has ignored this claim language because of the appearance of the word "enable." See pages 21-22 and 24-26 of the Office Action. Furthermore, the Office Action's comments make clear that the word "enable" has not been considered in the context of the limitation in which it appears. Under the Office Action's

(erroneous) interpretations, “a user interface configured to enable X” plainly is programmed exactly the same and thus is structurally equivalent to a “user interface configured to enable Y.” But this is plainly improper. As but one of many possible examples, one must agree that a jukebox’s user interface that is configured to enable a user to play a song for a fee is programmed differently and thus structurally distinguishable from a telephone’s user interface that is configured to enable a user to make a long distance call for a fee. The Office Action’s interpretations therefore are plainly improper.

In order that there be no doubt, Applicant has amended claim 71 to remove the term “enable.” Thus, reconsideration and withdrawal of this rejection are respectfully requested.

Claims 46, 56, and 64 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles in view of Waingrow, claims 50, 51, and 68-69 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles in view of Bowman-Amuah (U.S. Patent No. 6,289,382), and claims 52 and 70 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles and Bowman-Amuah, and further in view of Dunning (U.S. Patent No. 7,024,485). These rejections are respectfully traversed for at least the following reasons.

Fundamental deficiencies with the rejections of these claims’ parent claims have been discussed above and will not be repeated for the sake of brevity. Suffice it to say, however, that the introduction of Waingrow, Bowman-Amuah, and/or Dunning does not make up for these fundamental deficiencies. Moreover, these rejections are facially improper in view of the Office Action’s admissions regarding the features that Knowles plainly lacks. Thus, reconsideration and withdrawal of these rejections are respectfully requested.

### **Other Outstanding Issues**

Pages 19-26 of the Office Action make a number of representations to which Applicant does not necessarily acquiesce. For instance, although Applicant acknowledges that certain portions of the specification have been quoted, the purposes for which those quotations have been introduced are not always proper. For instance, the quotation from paragraph 6 of the specification may or may not be an admission of prior art and, even if it is, it may be Applicant's own prior art and not suitable for inclusion in a § 103 rejection. The quotations from paragraphs 9 and 23, on the other hand, most certainly are not prior art admissions. Moreover, the quotations from paragraphs 9 and 23 are indicative of certain illustrative features of various exemplary embodiments disclosed in the invention and are thus not to be read into the claims. However, it would appear that the Examiner has interpreted certain of these illustrative features as being necessary for all embodiments of all inventions -- which is plainly improper. A similar mistake is made regarding the exemplary arrangements shown in the drawings.

Applicant does not disagree with the citations to MPEP 2106.01 regarding non-functional descriptive material. However, Applicant disagrees with the blanket application of MPEP 2106.01 to the instant application, because the claims do not refer to music in the abstract.

Several of Applicant's objections to the circular definition of the term "location" have been noted above and will not be repeated herein. Applicant also generally objects to the need for such definitions in the first place, given the guidance for claim interpretation provided in the MPEP.

Applicant also generally objects to the treatment of certain claim features. Each and every limitation of a claim must be considered, and a limitation must be considered in its entirety. Thus, the arguments regarding music and alleged non-functional descriptive material,

the lack of a functional relationship between music and a storage medium, etc., are not understood or even applicable. Furthermore, just because a feature allegedly is shown in the prior art does not mean that it can be ignored for the purposes of examination and given “no patentable weight.”

Certain of Applicant’s objections regarding the language “configured to” and “enable” have been made above and will not be repeated herein. Suffice it to say, a computer component that is configured to do something has a particular structure that cannot be ignored. This is true in the context of both apparatus claims and method claims. If the Examiner has a preferred phrase rather than “configured to” that he believes should be included in the claims to improve their clarity, the Examiner is invited to contact the undersigned regarding the same. However, for the time being, there certainly is nothing wrong with Applicant’s phraseology, which appears in scores and scores of issued patents.

The Examiner is urged to reconsider the necessity and propriety of the remarks included on pages 19-26 of the Office Action, at least in view of the above and the specific guidance regarding claim interpretation and claim examination provided in the MPEP. Applicant would be happy to discuss these and/or any other issues in an interview if such would aid the Examiner’s understanding of the claimed invention, prior art, etc.

### **Conclusion**

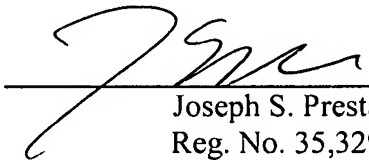
Applicant believes that all of the pending claims clearly and patentably distinguish the prior art of record and are in condition for allowance. Thus, passage of this case to issuance at an early date is earnestly solicited. Should the Examiner have any questions, or deem that any

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further issues need to be addressed prior to allowance, the Examiner is invited to call the undersigned attorney at the phone number below.

Respectfully submitted,

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